



Patent Facts

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Constitution

■ Congress shall have the power ...

- ↙ to regulate commerce with foreign nations, and among the several states, and with Indian tribes. -- U.S. Const. art. I, § 8, cl. 3.
- ↙ to **promote the progress of science and useful arts**, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.
-- U.S. Const. art. I, § 8, cl. 8.



Types of Application

- **Provisional – one year period, no claims required, written disclosure must meet same requirements as non-provisional, not allowed for design**
- **Non-Provisional – claims required, written description must meet requirements of 35 U.S.C. § 112, 1st paragraph. Examined for patentability, can result in a patent.**



Application Filing

■ Provisional

- ↪ Cover sheet
- ↪ Written description
- ↪ Drawings (where necessary)
- ↪ Fees

■ Non-Provisional

- ↪ Written description
- ↪ Drawings (where necessary)
- ↪ At least one claim
- ↪ Oath/Declaration
- ↪ Fees



Provisional Application

- **Provides filing date**
 - ↙ **Date of first filing**
- **Starts clock ticking**
 - ↙ **US non-provisional application**
 - **First to inventor to file can get patent rights**
 - ↙ **Foreign filing**
 - **First to file can get patent rights**
- **Protects against public disclosure**
 - ↙ **If non-provisional filed within year**



Non-provisional application?

■ Utility application

- ↙ Covers machines, articles of manufacture, processes, compositions of matter and improvements
- ↙ Can rely on provisional date
- ↙ Can become a patent

■ Fees

- ↙ filing/search/examination due at filing
- ↙ Issue due within three months of Notice of Allowance
- ↙ Maintenance fees are due at 3.5, 7.5 and 11.5 years after issue



Non-provisional application?

- **Longer wait for examination**
 - **Pendency of application could be years**
 - **Depends on technology**
 - **Higher number of filings longer wait**
- **Request for advanced examination**
 - **Accelerated examination**
 - **Special for age or health**
 - **Special programs**
- **20 year term from date of filing**



Design Application?

- Ornamental design of invention
 - ↪ No provisional applications
- Lower fees
 - ↪ \$220 filing/search/examination
 - ↪ \$410 issue
- Shorter wait for examination than utility
- 15 year term from issue



Application Prosecution

■ Pro se

- ↪ Prosecuting own application
- ↪ Must meet same standards as registered patent practitioners

■ Patent professional

- ↪ Registered Attorney or Agent
- ↪ Regulated by USPTO
- ↪ Trained in laws, rules and practice



Examination

- **Prior art**
- **Novelty vs. Anticipation**
- **Non-obvious vs. Obvious**
- **Best Mode, Enablement & Written description**
- **Time periods**
- **Amendments**



Office Action

- **Objections**
 - ↪ Provides formal requirements
 - ↪ Drawings, oath etc. deficiencies
- **Rejections**
 - ↪ Based on statutes
 - ↪ Utility, clarity, novelty and non-obviousness
- **Conclusion**
 - ↪ Information provided by examiner



Claims and Amendments

- **Metes and bounds of patent protection**
- **Define over prior art**
 - ↪ **May be simple word changes**
 - ↪ **May be combination of claims**
- **Broadness of claim**
 - ↪ **Broader claims offer greater protection**
 - ↪ **Narrow claims also needed**



Response to Office Action

- **Amendments**
 - ↪ **Must respond to all objections & rejections**
 - ↪ **Clarification of claim language**
 - ↪ **No new matter added**
- **Interviews**
 - ↪ **Phone or in person**
- **Filing of Appeal**
 - ↪ **If application finally rejected**



Allowance

- Time period
- Term
 - ↪ Utility, Plant and Design
- Maintenance of a Patent
- Patent Marking & “Patent Pending”



United States Patent and Trademark Office

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